

**REMARKS**

Claims 1, 3, 10-12, 14-16, 20, 21, 24, 25 and 79-101 were pending in the application. Claims 79, 91, and 94 have been amended. Claims 80 and 92 have been cancelled. Thus, with the entry of the listing of claims submitted herewith, claims 1, 3, 10-12, 14-16, 20, 21, 24, 25 and 79, 81-91, and 93-101 will be pending. Reconsideration of the pending claims is respectfully requested.

**Telephone Interview**

At the outset, Applicants would like to thank Examiner DiStefano for the courtesies extended during the telephone interview on August 6, 2009 with Applicants' representative (the undersigned). The participants discussed the rejection of independent claims 1, 79, and 91, as well as the objections to, and rejection of, dependent claims 25 and 90. In particular, Applicants' representative presented the arguments below against the rejection of claim 1. The Examiner indicated that based on these arguments, he would withdraw the rejection of claim 1 and would reconsider claim 1 after another search of the prior art. Moreover, the withdrawal of the rejection on these grounds would make any subsequent Office Action non-final. In addition, Applicants' representative discussed claims 79 and 91 as now amended. As amended, claims 79 and 91 include the limitations of now cancelled claims 80 and 92 and recite "providing a benefit to a user of the content consumption device in exchange for playing the selected audio content." In its rejection of now cancelled claims 80 and 92, the Office Action addressed the limitations that have now been added to claims 79 and 91. As such, Applicants also presented the arguments below against the references applied in the rejection of now cancelled claims 80 and 92. The Examiner indicated that he would search for new prior art that teaches the limitations that have now been added to claims 79 and 90. Applicants' representative also presented the arguments below against the objections to, and rejection of, dependent claims 25 and 90. Reconsideration of the pending claims in view of the discussion between Examiner DiStefano and Applicants' representative is respectfully requested.

Specification

The specification is objected to for failing to provide proper support for the claims. According to the Office Action, claims 25 and 90 recite limitations that are not sufficiently described in the application. *See* Office Action, p. 2, lines 12-17. In particular, claims 25 and 90 recite: “wherein the audio output channel is not free, and further comprising: playing the selected audio content on the content consumption device on a portion of the available audio output channel; and playing preferred content on the content consumption device on a remaining portion of the available audio output channel.” The Office Action asserts, however, that “applicant never describes how two separate contents may be played on a single audio channel.” *Id.*, p. 3, lines 1-2. Applicants respectfully traverse the objection, because support for the limitations in claims 25 and 90 can be found, for example, at paragraphs [0020]-[0021], which states:

[0020] Further, the preferred and selected content can be displayed simultaneously. For example, the selected content, such as advertising content in the form of a text banner streaming along the bottom of a screen of the content consumption device, can be displayed simultaneously with the preferred content, in the form of video for example, a movie or sports event or preferred content in the form of audio, for example, when a radio broadcast or musical content is being listened to on a content consumption device that has a video screen.

[0021] Accordingly, a channel need not necessarily be free, so long as a portion of the channel is available for playing the selected content. For example, in an analog TV broadcast, unused text space used to carry text pages to the TV screen, and which can be selected via a text mode, can be employed to play the selected content. In addition, in the case of Internet media distribution, for example, to a Windows Media Player running on a PC, and the like, the simultaneous display of the preferred and selected content can include popping up a corresponding window or windows, and the like.

*See* specification as published. Thus, based on the preceding paragraphs, the specification teaches that content on a content consumption device can be either video or audio, and that preferred and selected content can be displayed simultaneously by sending the selected content in an “available” or “unused” portion of the same channel carrying the preferred content. *Id.* Indeed, the specification describes simultaneously providing Internet media via Windows Media Player on a PC. *Id.*, paragraph [0021]. As is known, Internet media can include audio and/or video and Windows Media Player is capable of providing audio and/or video. Moreover, a single digital communication channel to a PC can deliver data for two separate contents. Thus, in the example provided by the specification, two Windows Media Players can be initiated on a

single PC, where each Windows Media Player provides audio content received over a single communication channel. Accordingly, Applicants respectfully submit that the specification provides sufficient support for the limitations of claims 25 and 89. Thus, withdrawal of the objection to the specification is in order and is respectfully requested.

**Claim Objections**

Claims 25 and 90 are objected to due to informalities. In particular, the Office Action asserts: “The claims contain the limitation of ‘the audio output channel is not free’. As claims 1 and 79, from which claims 25 and 90 depend, refer to the channel as being ‘available’, it is recommended that claim 25 be amended to contain similar terminology, e.g., ‘not available’.” Office Action, p. 3, lines 4-8. Applicants respectfully traverse the objection, because the present language of claims 25 and 90 accurately reflects the intended meaning and changing the language as suggested by the Office Action would impart the wrong meaning to the claims. As the specification explains, “a channel need not necessarily be free, so long as a portion of the channel is available for playing the selected content.” Specification as published, paragraph [0021]. Therefore, the concept of a “free” channel is distinct from the concept of an “available” channel. In particular, a channel can be “available” even if it is not “free.” A channel is “available” as long as a portion of the channel can be used for particular content, and a channel is not “free” if any portion of the channel is already being used for other content. Thus, claims 25 and 90 are directed to an embodiment where a portion of the channel is already being used for other content but remains available. Accordingly, Applicants respectfully submit that no correction to the claims is required. Thus, withdrawal of the objection to claims 25 and 90 is in order and is respectfully requested.

Claim 95 is objected to due to informalities. In particular, the Office Action asserts: “claim 95 refers to ‘the user preference’ which note [sic] recited in its current parent claims of 91. For this reason, the examiner assumes that claim 95 was intended to be dependent upon claim 94, as claim 94 refers to “determining a preference of a user.” Office Action, p. 3, lines 9-12. In view of the amendment to claim 95, Applicants respectfully submit that the objection has been rendered moot. Specifically, claim 95 is now dependent on claim 94. Thus, withdrawal of the objection to claim 95 is in order and is respectfully requested.

**Claim Rejections – 35 USC § 112**

Claims 25 and 90 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claims 25 and 90 recite: “wherein the audio output channel is not free, and further comprising: playing the selected audio content on the content consumption device on a portion of the available audio output channel; and playing preferred content on the content consumption device on a remaining portion of the available audio output channel.” The Office Action asserts, however, that the specification “make[s] no mention of playing two separate audio contents on a single channel, therefore this limitation is vague and unclear.” *Id.*, p. 4, lines 7-8 (emphasis in original). Based on the reasons provided previously in response to the objection to the specification, Applicants respectfully submit that the specification provides sufficient support for the limitations of claims 25 and 89. Thus, withdrawal of the rejection is in order and is respectfully requested.

**Claim Rejections – 35 USC § 102**

Claims 79, 81, 84, and 85 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. App. Pub. No. 2003/0037068 to Thomas et al. (“Thomas”). Claims 91, 97, and 98 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 6,351,736 to Weisberg et al. (“Weisberg”). In view of the amendments to independent claims 79 and 91, Applicants respectfully submit that claims 79 and 91 are novel and unobvious over the applied prior art. As amended, claims 79 and 91 include the limitations of now cancelled claims 80 and 92 and recite “providing a benefit to a user of the content consumption device in exchange for playing the selected audio content.” The Office Action acknowledges that Thomas and Weisberg “do[] not explicitly teach of providing a benefit to the user.” Office Action, p. 19, line 9; p. 23, line 20. In its rejection of now cancelled claims 80 and 92, the Office Action addressed the limitations that have now been added to claims 79 and 91. To reject now cancelled claims 80 and 92, the Office Action attempted to cure the deficiencies of Thomas and Weisberg by applying the teachings of U.S. Pat. App. Pub. No. 2002/0124182 to Basco et al. (“Basco”). In particular, the Office Action attempts to modify Thomas and Weisberg with the optimal dynamic pricing taught by Basco. *Id.*, p. 19, lines 9-14; p. 24, lines 1-6. The Office Action asserts that “as Basco describes in pg. 7, paragraph [0130] and [0131], dynamic pricing both benefits the user and encourages an

advertisement to be viewed as end users would get the most up to date information up until the exploitation of the advertisement opportunity.” *Id.*, p. 19, line 19-p. 20, line 2; p. 24, lines 11-14. Although Basco may disclose the use of optimal dynamic pricing, Applicants respectfully submit that optimal dynamic pricing optimizes how much the advertiser receives in compensation and not about a benefit that the consumer receives. *See* Basco, paragraphs [0129]-[0131]. Indeed, Basco is completely silent regarding the benefits of the optimal dynamic pricing for the consumer. *See id.* Furthermore, even if the consumer may indirectly benefit by “get[ting] the most up to date information” as suggested by the Office Action, nothing in Basco teaches or suggests that this benefit is provided as a part of an “exchange” where the consumer allows selected audio content to be played. Accordingly, the applied references fail to teach each and every element recited by claims 79 and 91 and fail to provide sufficient grounds for their rejection. Therefore, withdrawal of the rejection is in order and is respectfully requested. In addition, dependent claims 81, 84, 85, 97, and 98 are also allowable at least for the same reasons as their base claims 79 and 91.

**Claim Rejections – 35 USC § 103**

Claims 1, 10 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas, in view of GB 2,302,635 to Nishio. The Office Action acknowledges that “Thomas does not explicitly teach a method where the action performed is that of a fast forward action.” Office Action, p. 11, lines 9-10. Thus, the Office Action attempts to cure the deficiencies of Thomas by applying the teachings of Nishio. However, the references cannot be combined to teach or suggest “playing the selected audio content on the content consumption device on the available audio output channel simultaneously with the preferred content during the performing of the fast forward action” as recited in claim 1. First, the teachings of Thomas are directed to the playing of media during pause time, where clearly the preferred content is not simultaneously played. *See, e.g.*, Thomas, paragraphs [0010]-[0011]. Secondly, the teachings of Nishio indicate that the fast-forward occurs during “a nontransmission time.” Indeed, Nishio explains that a fast-forward command “never require[s] a transmission service of a video program.” Nishio, p. 17, lines 16-20. Moreover, Nishio explains: “[N]o video program or signal is transmitted from the video server 20A to the subscriber terminal 25a or 25b within the response time. The response time may therefore be referred to as a nontransmission time or an idle time. . . . The video

program selector 43 receives the response time and selects one of the special video programs that can be transmitted within the response time calculated by the response time calculator 42.” *Id.*, p. 21, line 27-p. 22, line 3; p. 22, lines 16-19 Thus, Nishio teaches that the preferred content is not simultaneously played during the fast-forward. In both references, the preferred content is not simultaneously played during the action, e.g., pause or fast forward. Accordingly, the applied references fail to teach each and every element recited by claim 1 and fails to provide sufficient grounds for its rejection. Therefore, withdrawal of the rejection is in order and is respectfully requested. In addition, dependent claims 10 and 14-16 are also allowable at least for the same reasons as their base claim 1. As discussed above, the Examiner has agreed to withdraw the rejection in view of these arguments.

Claims 3, 11, 12, 20, 21 and 24 are rejected under 35 U.S.C. 103(a) as being anticipated over Thomas in view of Nishio and further in view of Basco. Claims 80, 82, 83, and 87-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Basco. Claims 92, 94, 95, 96, 99, and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weisberg in view of Basco. Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weisberg in view of Thomas. Claim 101 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weisberg in view of U.S. Pat. App. Pub. No. 2002/0194592 to Tsuchida et al. Applicants respectfully submit that the Office Action has failed to cure the deficiencies of Thomas, Weisberg, Nishio, and Basco described previously. As such, dependent claims 3, 11, 12, 20, 21, 24, 80, 82, 83, 87-89, 92-96, 99, 100, and 101 are allowable at least for the same reasons as their base claims 1, 79, and 91 described previously. Accordingly, withdrawal of their rejections is in order and is respectfully requested.

**Conclusion**

The Applicants submit that the claims are in a condition for allowance and action toward that end is earnestly solicited. It is believed that no fees are due at this time; however, the Commissioner is authorized to charge any other fees which may be required in connection with this application (excluding the issue fee) or credit any overpayment to Nixon Peabody Deposit Account No. 19-2380 (Order No. 111325-500100).

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